

Serial No. : 09/756,508
Filed : 08 January 2001

REMARKS

In response to the first Office Action dated February 17, 2004 Applicant amends the Specification and certain claims to overcome the Examiner's §112 rejection and an improper reference number. Re-examination and reconsideration of the application is respectfully requested.

Claims 1 - 29 remain in the application.

The claims have been rejected based upon double patenting. Applicant includes herewith a Terminal Disclaimer to obviate this rejection.

Claim 1 was rejected based upon §112 and §103 as being obvious in view of Freidman '715 and Richardson ' 673. Applicant has amended the claim to overcome the Examiner's §112 rejection. Applicant now addresses the §103 rejection.

To establish a *prima facie* case of obviousness, there must be some **suggestion or motivation** (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) **to modify the reference** teachings. The prior art reference (or references when combined) must teach or suggest **all** the claimed limitations. MPEP §2143. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is **some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to those skilled in the art.** *In re Fine* 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.01. A statement that modifications of the prior art, to meet the claimed invention, would have been well within the ordinary skill in the art at the time the

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claimed invention was made, is not sufficient to establish *prima facie* obviousness without some **objective reason to combine the teachings of the prior art**. MPEP §2143.01. Further, if the proposed modification of the prior art would **change the principle of operation** of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. MPEP §2143.01.

Freidman discloses a game where the player plays one hand and is dealt two cards and is afforded the opportunity to discard. The dealer then exposes a card and the player's wager is resolved based upon whether the player's cards (both cards), in relation to the dealer's exposed card according to the following :

"... each player's wager is resolved depending upon whether **the player's two cards and the additional exposed card** form a predetermined winning relationship. Various predetermined winning relationships which may be employed include same card rank, same card suit, same card rank and suit, numeric sequence card rank, the additional exposed card having a rank falling between the ranks of the two player's cards, the additional exposed card having a rank equal to the sum of the of the player's two cards, and the additional exposed card having a rank equal to the difference of the rank of the player's two cards." (Emphasis added) Friedman, Col. 2, lines 30-38.

Claim 1 recites a game having features including; the player making a wager to play **at least two hands** of play and , which where the indicia are playing cards, provides that the player wins their wager for any hand if (1) the player has a card of the same characteristic (e.g. suit) of the outcome indicia (e.g. playing card) and (2) the outcome card

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has a higher ranking. Where the game is designated as a low game, for the player to win any hand, the outcome card must have a higher (or lesser) lesser rank than any same-suited card in the player's hand.

Friedman does not disclose these features and, it is respectfully submitted, teaches away from the method of claim 1. In Friedman, there is no disclosure of the player wagering on and playing at least two hands. The feature of playing multiple hands, it should be understood, gives the player multiple opportunities to win a wager. Further, Friedman does not disclose a game where the player's cards must contain a card of the same suit and where the same-suited outcome card is one of a designated higher or lower ranking.

Thus the method of the present invention is not taught by Friedman nor is there any suggestion of using a same suit and different rank to determine a winning outcome. The provision for at least two hands also gives the player multiple opportunities to win.

While the Examiner has taken the position that Friedman discloses the relationship feature of claim 1, applicant respectfully traverses this position. Friedman DOES NOT disclose a game where, for the player to win, the player needs to have a card of the same suit as the outcome card but the outcome card must be a designated one of a higher or lower ranking. It should be noted that Friedman discloses a game where the player's "two" cards fall within the defined winning relationship. Col. 2, lines 28 - 30.

Richardson also does not disclose or suggest a multiple hand game (as acknowledged by the Examiner).

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Richardson also does not disclose designation of the game as a high or low game. In Richardson, the player must place their wager by selecting high or low.

It is respectfully submitted that neither Friedman or Richardson shows or suggests designation of the game as high or low (no player choice), having the player play a plurality of hands, a game where to win the outcome indicia (card) must be of the same suit as one of the player's cards AND have a rank of the designated higher or lower ranking. In Friedman, the inquiry is the relationship of the result card compared to both of the player's cards whereas in the present invention the player need only have one card to trigger a winning outcome.

Nor is there any suggestion for combining Richardson and Friedman. There is no suggestion or disclosure as to the desirability of modifying Friedman (which does not disclose the game method rule of claim 1 for determining a winning or losing outcome) with the teachings of Richardson. The games are different in approach. Friedman DOES NOT disclose the high - low game of claim 1 as discussed above. Friedman sets forth a game where the player attempts to have both his cards form the winning relationship with the result card.

Applicant respectfully submits that claim 1 is in condition for allowance.

Claim 2 depends from claim 1 to recite presenting an outcome indicia for each hand. For the reasons advanced above and inasmuch as neither of the cited references teach playing multiple hands, it is submitted that claim 2 is likewise in condition for allowance.

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Claim 3 depends from claim 1 to recite that the indicia are playing cards. For the reasons advanced with respect to claim 1, allowance of claim 3 is respectfully submitted.

Claim 4 depends from claim 1 to recite that the player has the option of discarding and receiving replacements. In regards to the method of claim 3 (where the indicia are playing cards), the arrangement of the game method provides an entirely different game strategy than in Friedman. In the method of claim 1 (assuming the game is a "low" game) the player's choices to discard and hold are markedly different than would be employed in Friedman. In the method of claim 3, and assuming that the player's hand includes two cards, the player would attempt to have high cards in different suits to give him the best chance of winning. Thus if the player were dealt:

A♥ 2♦

he would discard the 2♦ hoping to get a high Club, Spade or Diamond card (so the outcome card will be lower. In Friedman, the player would:

(1) Discard one of the cards to get a pair or a two card flush where the game is a same rank, same suit or same rank and suit game (hoping to get, with the result card, three of a kind (same rank), or a three card flush);

(2) Hold both where the game is one of numeric sequence (hoping for a 3);

(3) Hold both where the game is one where the result card must be between the ranks of the player's two cards (hoping for any card except an Ace or a 2);

(4) Hold both where the result card is the sum of the player's two cards (hoping for a 3); and

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(5) Hold both where the result card is difference of rank between the player's cards (hoping for a Queen).

Richardson also does not disclose or suggest a multiple hand game (as acknowledged by the Examiner). Richardson also does not disclose providing the player with the option to replace cards, as recited in claim 1. (See the Decision by the Board of Patent Appeals and Interferences in the decision regarding the parent case (Appeal No. 2002-0928) where the Board stated;

"Even if the teachings of Richardson and Weiss were combined ... this would not result in the subject matter of any of .. [the claims], that is a single game wherein the player has the option of discarding and replacing cards to improve his or her hand and whereupon the player is rewarded based on whether any card of his or her final hand beats an outcome card of the same suit." (Decision , Page 4 - 5)).

Richardson also does not disclose designation of the game as a high or low game. In Richardson, the player must place their wager by selecting high or low.

It is respectfully submitted that neither Friedman or Richardson shows or suggests designation of the game as high or low (no player choice), having the player play a plurality of hands, a game where to win the outcome indicia (card) must be of the same suit as one of the player's cards AND have a rank of the designated higher or lower ranking. In Friedman, the inquiry is the relationship of the result card compared to both of the player's cards whereas in the present invention the player need only have one card to trigger a winning outcome.

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Nor is there any suggestion for combining Richardson and Friedman. There is no suggestion or disclosure as to the desirability of modifying Friedman (which does not disclose the game method rule of claim 1 for determining a winning or losing outcome) with the teachings of Richardson. The games are different in approach. Friedman DOES NOT disclose the high - low game of claim 1 as discussed above. Friedman sets forth a game where the player attempts to have both his cards form the winning relationship with the result card.

Allowance of claim 4 is respectfully requested.

Claim 5 depends from claim 3 to recite the discard - replacement feature where the indicia are playing cards. In view of the remarks with regard to claims 3 and 4 above, allowance of claim 5 is requested.

Claim 6 depends from claim 1 to recite the display of four indicia. In view of the remarks made above with respect to claim 1 and the failure of Friedman to disclose dealing four indicia, allowance of claim 6 is requested.

Claim 7 depends from claim 3. In view of the remarks made above with respect to claims 1 and 3 above, allowance of claim 7 is solicited.

Claim 8 depends from claim 7 to recite the discard - replacement feature. In view of the remarks above, allowance of claim 8 is requested.

Claim 9 has been amended to overcome the Examiner's §112 rejection. This claim recites the features of claim 1 where the indicia are playing cards and is directed to a "low"

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game. In view of the remarks made with respect to claim 1, allowance of claim 9 is requested.

Claim 10 depends from claim 9 to recite the discard - replacement feature. In view of the remarks made above with respect to claims 1 and 4 above, allowance of claim 10 is solicited.

Claim 11 depends from claim 9 to recite the discard - replacement feature prior to revelation of the outcome card. In view of the remarks made above with respect to claims 1 and 4 above, allowance of claim 10 is solicited.

Claim 12 depends from claim 9 to recite displaying four game cards. In view of the remarks above with respect to claim 6, allowance of claim 12 is solicited.

Claim 13 recites a method along the lines of claim 9 for a "high" game. In view of the remarks above, allowance of claim 13 is solicited.

Claims 14 - 15 depend from claim 13 to recite the discard - replacement feature and the exercise of the feature before revelation of the outcome card. For the reasons advanced above, allowance of these claims is requested.

Claim 16 is directed to an apparatus claim drawn along the lines of claim 1. This claim has been amended to overcome the Examiner's §112 rejection. The remarks above with respect to claim 1 are incorporated by reference. Allowance of claim 18 is respectfully requested.

Claims 17 - 18 depend from claim 16 to recite the discard - replacement feature. Claim 19 also depends from claim 16 and recites an apparatus where four game indicia are

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selected for each hand. Claim 20 depends from claim 16 to recite that the indicia are playing cards. For the reasons advanced above, allowance of these claims is also requested.

Claim 21 is an apparatus claim drawn along the lines of claim 16 (and method claim 13) for a "high" game. The Examiner has rejected this claim under §102 in view of Friedman.

For anticipation, a single prior source or reference must contain all of the essential claimed elements. Chisum, *Chisum on Patents* § 3.02, *Gechter v. Davidson*, 116 F. 3rd 1454; 43 USPQ2d 1030 (Fed. Cir. 1997). Friedman does not disclose or suggest the play of multiple hands or the determination of when a player is entitled to an award, e.g. the outcome card outranks any same suited player game card. For these and the reasons set forth above, allowance of claim 21 is respectfully requested.

Claims 22 -24 depend from claim 21 and have been rejected on the same grounds. For the reasons advanced above with respect to claim 21, allowance of claims 22 - 24 is requested.

Claim 25 depends from claim 21 to recite the processor selecting an outcome card for each of the plurality of game hands. Friedman does not disclose or suggest the play of multiple hands or the selection of an outcome card for each of the hands. Allowance of claim 25 is solicited.

Claim 26 recites a method along the lines of claim 1 wherein the indicia are playing cards, the game is a "low" game, the player plays at least two hands and where the player

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can discard and replace cards. For the reasons advanced above, allowance of claim 26 is requested.

Claim 27 is a method claim drawn along the lines of claim 26 for a "high" game. In view of the remarks above, allowance of claim 27 is requested.

Claim 28 recites a method along the lines of both claims 26 and 27. For the reasons advanced above with respect to claim 1, allowance of claim 28 is solicited.

Claim 29 has been rejected as anticipated by Friedman. Applicant has amended this claim to correct a typographical error. For the reasons advanced with respect to claims 21 - 25, it is respectfully submitted that Friedman does not anticipate. Friedman does not disclose playing multiple hands or the winning determination protocol recited in the claim. Allowance of claim 29 is respectfully requested

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CONCLUSION

For the reasons advance above, it is submitted that all pending claims are in condition for allowance. Allowance of all pending claims is solicited.

Should the Examiner feel that a telephone interview would advance the case on the merits, the undersigned respectfully requests a telephone interview.

Respectfully submitted,

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Dated: April 30, 2004

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